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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,173	06/08/2001	Steven Rizzi	00479.00023	5726
22907	7590	12/15/2006	EXAMINER	
BANNER & WITCOFF			JANVIER, JEAN D	
1001 G STREET N W			ART UNIT	PAPER NUMBER
SUITE 1100				3622
WASHINGTON, DC 20001				

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/876,173	RIZZI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jean Janvier	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-40 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____.                         |

## **DETAILED ACTION**

### *Specification*

### *Claim Status*

Claims 1-30 and 31-40 are currently pending in the Application.

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-30 and 31-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Gerace, WO 97/41673.

(In claims 1, 21, 30 and 37, the claim amendment and new claim limitation is read as “**no user profiling data are forwarded to the advertising server 140 for collection**”, wherein the advertising server 140 is an external advertising server or a third party advertising server that should not collect or access the users’ profile data).

As per claims 1-30 and 31-40, Gerace discloses a system for displaying advertisements to

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a user, over the Internet, based on the user's preferences (interests, habits or psychographic or **behavioral profile** or specification information). The user's psychographic profile and demographic profile are collected from the user during a registration or an enrollment or sign-up process. **Thereafter, the psychographic profile is constantly refined using the user's viewing habits (or exposure to content) and computer activity.** Further, content of categories of interest and display format in each category are included in the psychographic profile as a result of the user's viewing or browsing activities (**tracking the user's interactions with displayed content (text) or targeted agate information, using this interaction to refine the user's profile that is utilized to present more targeted advertisements to the user**). Consequently, targeted advertisements are appropriately displayed to the selected user via his computer screen, based on the user's psychographic profile (viewing habits), when he logs, using his password or identifier and login name, into the system to request a primary content and wherein these advertisements are constantly being refined in accordance with the user's interaction or viewing activities or psychographic or behavioral profiles.

(Requesting by a user from a web server agate information or text (web page content), providing advertisements retrieved from the web server (advertising server) and the requested content to the user, wherein the advertisements are displayed on the user's screen along with the requested content or text....).

See abstract; figs. 2, 3B-3G; p. 3: 2 to p. 5: 19; p. 13: 1-22; p. 39: 22 to p. 45: 7.

Furthermore, the user is exposed to various primary contents (objects or textual content) or agate information, such as weather, news, stock, etc., when he logs in using a piece of software or program 31 (applet received from the web server). Program 31, after many sessions,

collects information indicative of the user's categories of interest **and automatically tailors advertisements to the user, based on the user's interactions with the user's categories of interest, to the user and in accordance with the (an) advertiser's criteria (promotional heuristics) to present the advertisements.** As such, each time the user logs on, program 31 features or displays items (primary content or agate information), before distributing advertisements including product promotions, that are more interesting and/or appealing to the user (displaying advertisements based on textual information). **When the user selects (i.e., "clicks on") a displayed advertisement, the corresponding Ad Package Object 33b of fig. 5B records a "click through". This affects the ranking and criteria weighting calculations and further refines the terms of elements to be displayed/presented to the user. Thus the present system \provides a means and method for continually refining the target profile for advertisements** (tracking or monitoring the user's reaction to a displayed advertisement as recorded by Ad Package 33b or database.... -p. 32: 26 to p. 33: 8; p. 21: 18-37).

In addition, Gerace discloses a system wherein advertisements will be shown to a user who logs into the system to read (requested) primary suggested or anticipated content or agate information in accordance with the user's viewing habits matching an advertiser's targeted profile or criteria (promotional heuristics) based on a weighting scale (comparison) (p. 23: 15-27; p. 28: 25 to p. 29: 34; p. 34: 25-34).

Advertising information and desired ads of an advertiser's are stored in ad package object 33c (or 33b) and 33d (database) respectively. User's profile, including psychographic viewing data (exposure to primary content), is stored in module 73, advertising data are recorded in module 75 and agate information or primary content is stored in module 71, coupled to Web

Server 27 running program controller or software application 79 (fig. 2; p. 8: 1-37; p. 34: 20-24).

A subroutine coupled to a module performs a regression analysis on the recorded history of users viewing the displayed ads. The subroutine refines profiles of the users based on the regression analysis. Preferably, the regression analysis weights the relative importance of psychographic characteristics of users. Over time, the advertisements are better targeted to users.

**Moreover, a sponsor and user objects track how many times each advertisement information is shown, selected, and/or triggered a purchase by users (tracking the user's reaction to a displayed ad....). In other words, the sponsor and user objects track performance of the advertisements provided by the sponsor or advertiser and a performance routine or module, employing a regression analysis techniques, provides a performance reports to advertisers or sponsors, who may refine or adjust the weighting assigned to each advertisement object related to an advertisement based on the performance of one or more advertisements displayed to a plurality of targeted users in an effort to maximize/optimize the success of the ads displayed through the network.**

**Moreover, a generated and detailed packaged report provides information on individual ad packages. The required demographic profiling and demographic breakdown of success with respect to a targeted group and the number of hits and click-through purchases generated are included in the detailed package report. In the demographic response rates report, all ads from a sponsor or selected ones and the ad success with the sponsor-targeted groups are compared or reviewed. To do so, a regression analysis is performed on the demographically targeted groups who viewed the ads and the results of the analysis are used to suggest other demographic characteristics of importance, which may help achieve the**

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number of click-throughs and/or triggered purchases. In other words, the system modifies or refines the demographic parameters of the ad objects based on the statistical data collected from the users who were exposed to the ads, wherein, following this modification, the system re-compares the demographics of the users to the sponsor's specified and modified demographic factors to determine if one or more users are good candidates to receive the sponsor's ads. A sponsor-user logs into the system and uses authentication information (password/company's ID, login name) stored in the server database, to access the server and view an associated report stored in the server database. The sponsor (sponsor-user) uses the same credentials or authentication information to download crafted advertisements to the server to be stored in the database). **Here, a report, but not a specific user's profile and his identity per se, showing, inter alia, a demographic breakdown of the users exposed to an ad, the number of hits for the ad and so on is generated and made available to the advertiser related to the displayed ad.**

(P. 34: 35 to P. 37: 21).

(Page 4: 9-21; page 5: 10-19; page 9: 26 to page 10: 3; page 25: 1-20 ; page 28 : 25 to page 29: 12 ; **page 29 : 13-34.**

In general, Gerace discloses a method and apparatus for providing targeting of appropriate audience based on psychographic or behavioral profiles of end users. The psychographic profile is formed by recording computer activity and viewing habits of the end users viewing or reading content. Content of categories of interest and display format in each category are revealed by the psychographic profile, based on user viewing of aggregate information. Using the profile (without additional user demographics), advertisements are displayed to appropriately selected users and

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in accordance with the advertiser's criteria. Based on regression analysis of recorded responses of a first set of users viewing the advertisements, the target user profile is refined. Viewing by and regression analysis of recorded responses of subsequent sets of users continually auto-targets and customizes ads for the optimal end user audience. In other words, the system uses agate information or content to determine the profile of a computer user, and in particular the behavioral or psychographic profile, as distinguished from the demographic profile, of the user (See abstract; P. 3: 1-16).

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-30 and 31-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Graham, USP 6,804,659.

(In claims 1, 21, 30 and 37, the claim amendment and new claim limitation is read as “**no user profiling data are forwarded to the advertising server 140 for collection**”, wherein the

advertising server 140 is an external advertising server or a third party advertising server that should not collect or access the users' profile data).

As per claims 1-30 and 31-40, Graham discloses an Internet target marketing system, method and computer program for distributing online advertising messages to viewers based upon the viewers' interests. One specific embodiment uses an n-way matching of user's concepts of interest, advertiser's concepts (criteria to display advertisements) and a currently viewed document to target advertising to the view of the current document. Some other embodiments generate a contextually sensitive advertisement for each page viewed in a browser, thereby associating an advertisement with every page in a document. Specific embodiments can associate advertising messages with documents that are substantially free of embedded advertisements. Alternative embodiments can include embedded advertising (see abstract).

In one specific embodiment of the present system, a method for targeting advertising to a user based upon content of an active document is provided. An active document can be one that is presently displayed to a user, for example. However, in some embodiments, an active document can be one that is being processed by a daemon or background process. The method includes analyzing at least one document to identify discussion of information corresponding to one or more user selectable concepts of interest. This analysis can provide a user concept relevance, which can comprise a measure of relevance of the document to one or more concepts defined by the user. The method can also include analyzing the document to identify discussion of information corresponding to one or more advertiser selectable concepts of interest. This analysis can provide an advertiser concept relevance, which can comprise a measure of relevance

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of the document to one or more concepts defined by the advertiser. The method can also include comparing the user concept relevance and the advertiser concept relevance for the document to determine an overall relevance. Selecting advertising having a particular overall relevance can also be part of the method. The particular relevance can be the greatest relevance, least relevance, or within a range of greatest or least relevance, for example. The method can also include displaying the advertisement selected to a user.

In another embodiment, a system for targeting advertising to a user based upon content of one or more documents displayed to the user is provided. The system comprises a profile content recognizer that analyzes contents of documents for information corresponding to one or more user selectable concepts. The profile content recognizer provides an output of concepts contained in the document that correspond to the one or more user selectable concepts. The system also comprises an advertising content recognizer that analyzes content of documents for information corresponding to one or more advertiser selectable concepts. A comparator compares the output from the profile content recognizer and the output from the advertising content recognizer and selects from a plurality of stored advertisements ones that are relevant to the information contained in the documents based upon the comparison.

(Here, the advertising server is part of the internal system and hence, the users' profile data are not collected and provided to any third party or external advertising server, but rather are collected and used internally for targeting the users).

Figs. 1-11; Col. 1: 51 to col. 3: 44).

Please consider the entire disclosure.

### Response To Applicant's Arguments

First, although the claims or at least the independent claims 1, 21 and 30 recite "wherein no user profile data is forwarded to the advertising server", however, the specification discloses in general a system and method for providing advertising on the Internet in which **an advertiser targets particular users**, while maintaining a high degree of privacy (see abstract) (by not releasing users' profile data to the advertiser or without the advertiser collecting the users' profile by tracking the users' activities). In fact, the specification expressly recites, with respect to the claim amendment, that "**no user profiling data is forwarded to the advertising server 140 for collection**" [see 0043 of the specification], which does not necessarily mean that the users' profile data are not collected and used for targeting the users.

Here, it appears rather, in the present invention, that the advertising server 140 represents an external third party's server that should not have access to the user's profile. To this end, as long as the users' profile data are not collected and provided to an external advertising server 140 or external third party, the claim limitation or claim amendment is met. Indeed, in the prior art of record (the Gerace's or Graham's), the advertising server is part of the internal system and hence, the users' profile data are not collected and provided to any third party or external advertising server, but rather are collected and used internally for targeting the users contrary to the Applicant's contention. Further, the matching or comparing process is performed locally or internally by the system, but not by a third party or external advertising server and the advertisers submit before hand their advertising data (including advertisements) along with target criteria to the system, which displays the advertisements to qualified users. Hence, the users' privacy is maintained as outlined in the specification.

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Moreover, neither Gerace nor Graham expressly discloses collecting and providing a user's profile to an advertiser or an external advertising server 140 for preparing targeted advertisements to be presented to the user. **In Gerace or Graham, "no user profiling data is forwarded to the external advertising server 140 (third party server) for collection".**

### Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USP 5,794,210A to Goldhaber discloses a system that provides for the immediate payment to computer and other users for paying attention to an advertisement or other "negatively priced" information distributed over a computer network such as the Internet. Called Attention Brokerage, this is the business of brokering the buying and selling of the "attention" of users. A further invention, Orthogonal Sponsorship, allows advertisers to detach their messages from program content and explicitly target their audience. A special icon or other symbol displayed on a computer screen may represent compensation and allow users to choose whether they will view an ad or other negatively priced information and receive associated compensation. Targeting users may be provided by reference to a database of digitally stored demographic profiles of potential users. Information can be routed to users based on demographics, and software agents can be used to actively seek out users on a digital network. **Private profiles may be maintained for different**

**users and user information may be released to advertisers and other marketers only based on user permission. Users may be compensated for allowing their information to be released.** Competing advertisers may "bid" for the attention of users using automatic electronic systems, e.g., "an auction" protocol and these concepts can be generalized to provide an electronic trading house where buyers and sellers can actively find each other and negotiate transactions.

USP 6,029,195 to Herz relates to customized electronic identification of desirable objects, such as news articles, in an electronic media environment, and in particular to a system that automatically constructs both a "target profile" for each target object in the electronic media based, for example, on the frequency with which each word appears in an article relative to its overall frequency of use in all articles, as well as a "target profile interest summary" for each user, which target profile interest summary describes the user's interest level in various types of target objects. The system then evaluates the target profiles against the users' target profile interest summaries to generate a user-customized rank ordered listing of target objects most likely to be of interest to each user so that the user can select from among these potentially relevant target objects, which were automatically selected by this system from the plethora of target objects that are profiled on the electronic media. Users' target profile interest summaries can be used to efficiently organize the distribution of information in a large scale system consisting of many users interconnected by means of a communication network. Additionally, a cryptographically-based pseudonym proxy server is provided to ensure the privacy of a user's

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target profile interest summary, by giving the user control over the ability of third parties to access this summary and to identify or contact the user.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

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Jean D. Janvier

JDJ

Patent Examiner

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JEAN D. JANVIER  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "Janvier Jean D." followed by "D.J." in a smaller script.